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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,091	09/04/2003	James J. LeKachman	47004.000216	5822
21967 7590 12/01/2010 HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109				
EXAMINER				
TRAN, HAI				
ART UNIT		PAPER NUMBER		
3694				
MAIL DATE		DELIVERY MODE		
12/01/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/654,091

**Applicant(s)**

LEKACHMAN, JAMES J.

**Examiner**

HAI TRAN

**Art Unit**

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This is the communication in response to the Amendments/Remarks filed on September 16, 2010, for application, titled: "System and Method for Financial Instrument Pre-Qualification and Offering".

***Status of the Claims***

2. Claims 14, 19, 26, 27, and 31 have been amended. No claim has been cancelled. Accordingly, claims 1-31 remain pending and have been examined.

***Priority***

3. This application claims the priority of U.S. Provisional Patent Application No. 60/407,696, filed on 09/04/2002, is acknowledged.

***Information Disclosure Statement (old)***

4. In the last Office Action, Examiner requested Applicant to point out which references listed in the IDS are more specifically relevant to the invention. However, Applicant has not yet replied.

***Drawings Objections***

5. The drawings are objected to because figures 1 and 2 do not show any labels. The figures only show the numbers in the boxes without any label to explain what the

boxes mean. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application.

6. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101 (old)***

7. With respect to the rejection of claims 1 and 12, Examiner searched Applicant's specification and did not identify any information that describes the "receiving unit", "first interface unit", "second interface unit", and "third interface unit" are configured on hardware. Examiner suggests that Applicant adds the phrase of "a processor," after "comprising:" and before the "a receiving unit", and also adds the phrase of "on a

hardware" after the phrases of "a receiving unit configured", "a first interface unit configured", "a second interface unit configured", and "a third interface unit configured" (i.e. "a receiving unit configured on a hardware") to assure the claims meet the requirements. Claim 12 is also required to be amended the same to meet the requirements.

8. With respect to the rejection of claim 3, Examiner withdraws the rejection; however, no patentable weight will be given to this limitation due to the reason that it does not fall into one of the four recognized statutory categories under 35 USC 101.

9. With respect to the rejection of claims 14 and 31, Applicant has amended the claims in an effort to overcome the rejection. However, Examiner still suggests that Applicant amends the phrase of "a method" in the preamble of claims 14 and 31 to "a computer-implement method" to show that the methods are implemented via a computer.

#### ***Claim Rejections - 35 USC § 112***

10. Applicant has clarified the confusion. Hence, the rejection is withdrawn.

#### ***Response to Arguments***

11. Applicant's arguments with respect to claims 1-31 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Vasic (U.S. Patent Application Publication 2001/0034676) ("Vasic").

14. **As per claim 14**, Vasic teaches a method for offering financial instruments to pre-qualified consumers, comprising:

receiving from a database information related to personal identification information associated with a consumer who is a customer of at least one of a financial institution and an entity associated with the financial institution (see Vasic, par. 68 "employee", Figure 1. Examiner notes that the "employee" is the same as the "consumer" of the Applicant's invention), the consumer personal identification information being received prior to a consumer contact (see Vasic, Figure 4/steps 1-2 "employee information is given to payroll service and/or employer", "payroll service and/or employer forwards employee information to payroll access company", par. 26 "the payroll access company can a large master account with funds sufficient to cover payroll access for numerous employees and have separate sub accounts for individual employees that remain empty and inactive until an employee requests access");

a programmable processor inquiring a third party based on the received information related to the consumer personal identification information whether the consumer has been pre-qualified for a financial instrument, the financial instrument associated with the financial institution, wherein the pre-qualification is based at least in part on a first consumer file (see Vasic, par. 26 "master account", Figure 4/step 3 "payroll access company gathers information on employees". Examiner notes that the "payroll access company" is the same as the "third party" of the Applicant's invention);

receiving pre-qualification data from the third party wherein the pre-qualification data relates to a determination of whether a consumer identifier associated with the consumer is contained in a suppression database (see Vasic, Figure 4/step 3 "payroll access company gathers information on employees". Examiner notes that the "information gathered" is the same as the "suppression database" of the Applicant's invention), wherein the suppression database comprises a plurality of second consumer files, each of the second consumer files linked to a unique consumer identifier (see Vasic, par. 26 "secondary payroll access resource such as a sub-account of the master account", Figure 4/step 3 "determines payroll access ATM card limit then forwards the pertinent information to bank"), wherein the second consumer files comprise suppression information relating to a determination that the consumer associated with the second consumer file is no longer qualified to be offered one or more of the pre-qualified financial instruments stored in the first consumer file (see Vasic, Figure 4/step 3 "determines payroll access ATM card limit");

the programmable processor requesting data periodically for requalification of the consumer prior to a consumer contact to reduce a likelihood of offering a financial instrument for which a consumer is no longer qualified (see Vasic, Figure 4/step 3 "gathers information on employees", par. 26 "the sub-accounts for each individual employees remain empty and inactive until an employee requests access", par. 27 "access to payroll access resource is provided to the employee on demand"); and

the programmable processor offering the consumer the financial instrument for which he or she is pre-qualified (see Vasic, par. 28 "the amount to the employee is limited based upon each individual's normal paycheck", par. 53 "the payroll access resource is a line of credit tied to the employee's payroll"), if the received pre-qualification data from the third party indicates that the consumer is pre-qualified for a financial instrument (see Vasic, Figure 4/step 4 "bank issues payroll access ATM card to employee"),

wherein the standards for the consumer pre-qualification are set by the financial institution (see Vasic, par. 68 "the access can be provided by establishing an account at a bank", Figure 1/ "third party bank").

15. **As per claim 15**, Vasic teaches wherein pre-qualification of the consumer comprises checking at least one of the credit rating of the consumer, the income level of the consumer, the debt level of the consumer and the payment history of the consumer with the financial institution (see Vasic, par. 28 "the amount to the employee is limited may be based on the employee's normal paycheck, the relative risk of loss or non-



payment", "the employee's financial history or employment history at the time of the request", Figure 4/step 3, par. 53 "the payroll access resource is a line of credit tied to the employee's payroll").

**As per claim 16**, Vasic teaches wherein pre-qualification of the consumer occurs prior to receipt of the consumer personal identification information (see Vasic, par. 26 "the payroll access company can keep a large master account with funds sufficient to cover payroll access for numerous employees and have separate sub accounts for individual employees that remain empty and inactive until an employee requests access").

**As per claims 17-18**, Vasic teaches wherein the third party maintains consumer information in files indexed by a unique identifier, and wherein the unique identifier relates to the personal identification information of the consumer (see Vasic, Figure 4/step 3 "social security number, "ATM card access code").

**As per claim 19**, Vasic teaches further comprising the programmable processor offering the financial instrument to the consumer only if the consumer credit rating meets or exceeds a pre-determined condition (see Vasic, par. 28, 67 "the website and materials available on the website could serve as proof of income and for loans, credit card companies", par. 53 "the payroll access resource is a line of credit tied to the

employee's payroll", par. 70 "credit card company acts as the payroll access company", Figure 3).

**As per claims 20-21**, Vasic teaches wherein the financial instrument comprises any financial instrument for which credit information relating to the consumer is predictive (see Vasic, par. 53 "the payroll access resource is a line of credit tied to the employee's payroll", par. 70, Figure 3), and wherein the financial instrument comprises at least one of a car loan, boat loan, loan on investment property, margin account, business loan, second mortgage, home equity line of credit, consumer loan, transaction card, credit card, loyalty card, co-branded credit card, debit card, rewards card, smart card, mutual fund or insurance (see Vasic, par. 5 "short term loans", par. 8 "loan", par. 67 "the website and materials available on the website could serve as proof of income and for loans, credit card companies").

**As per claim 22**, Vasic teaches wherein the consumer is offered the financial instrument only if one or more pre-determined conditions are met (see Vasic, par. 28 "the amount to the employee is limited may be based on the employee's normal paycheck, the relative risk of loss or non-payment", "the employee's financial history or employment history at the time of the request", par. 53 "the payroll access resource is a line of credit tied to the employee's payroll", Figure 4/step 3 "gathers information on employees", "determines payroll access ATM card limit").

**As per claim 23**, Vasic teaches wherein the consumer personal identification information is obtained when the consumer makes contact comprises a purchase from a merchant (see Vasic, par. 26 "sub accounts for individual employees remain empty and inactive until an employee requests access").

**As per claim 24**, Vasic teaches wherein the consumer personal identification information is obtained through contact comprises one of a communication from a business partner of the financial institution or a communication directly to the financial institution (see Vasic, par. 68-70, 72-74, Figures 1-3, 5-7).

**As per claim 25**, Vasic teaches wherein consumer personal identification information is obtained through a telephone call or contact over a computer network (see Vasic, par. 68-70, 72-74, Figures 1-3, 5-7).

**As per claim 26**, Vasic teaches further comprising the programmable processor offering the financial instrument only upon the acceptance of any terms and conditions related to the financial instrument by the consumer (see Vasic, par. 5 "short term loans". Examiner notes that if the consumer does not accept the terms and conditions, the financial instruments will not be offered).

**As per claim 27**, Vasic teaches further comprising the programmable processor offering the financial instrument to the consumer only if the identity of the consumer is authenticated (see Vasic, par. 68, Figure 4/step 3 “gathers information on employees”).

**As per claim 28**, Vasic teaches wherein authenticating the consumer comprises favorable comparison of stored consumer information to consumer personal identification information (see Vasic, par. 68, Figure 4/step 3 “gathers information on employees”).

**As per claim 29**, Vasic teaches wherein the consumer personal identification information comprises at least one of a calling telephone number, a PIN, a password, a biometric or any other information known or held by the consumer and generally not known to the public that can be used to authenticate the consumer (see Vasic, Figure 4/step 3).

**As per claim 30**, Vasic teaches wherein authentication is performed by the third party (see Vasic, par. 68-70, 72-74, Figure 1-3, 5-7 “third party”).

16. **As per claim 31**, this claim is similar to claim 14 except that it includes the limitation of “wherein further the financial instrument comprises any financial instrument for which credit information relating to the consumer is predictive” which is the limitation

in claim 20. Hence, this claim is rejected under the same rationale provided in claims 14 and 20 (see discussion above).

17. **As per claim 1**, this claim written in system form is similar to claim 14 except that it includes the interface units for receiving data, database for managing data, and the limitation of "wherein the pre-qualification data relates to at least one financial instrument associated with ..." (see Vasic, par. 68 and Figure 1). Hence, it is rejected under the same rationale provided in claim 14.

18. **As per claim 2**, this claim written in system form corresponds to claims 17 and 18. Hence, it is rejected under the same rationale provided in claims 17 and 18.

19. **As per claim 3**, this claim written in system form corresponds to claim 25. Hence, it is rejected under the same rationale provided in claim 25.

20. **As per claim 4**, this claim written in system form corresponds to claim 25. Hence, it is rejected under the same rationale provided in claim 25.

21. **As per claims 5-6**, these claims written in system form correspond to claim 27. Hence, they are rejected under the same rationale provided in claim 27.

22. **As per claim 7**, this claim written in system form corresponds to claim 29.

Hence, it is rejected under the same rationale provided in claim 29.

23. **As per claim 8**, this claim written in system form corresponds to claim 27.

Hence, it is rejected under the same rationale provided in claim 27.

24. **As per claim 9**, this claim written in system form corresponds to claim 15.

Hence, it is rejected under the same rationale provided in claim 15.

25. **As per claim 10**, this claim written in system form corresponds to claim 19.

Hence, it is rejected under the same rationale provided in claim 19.

26. **As per claim 11**, this claim written in system form corresponds to claim 26.

Hence, it is rejected under the same rationale provided in claim 26.

27. **As per claim 12**, this claim written in system form is similar to claim 31 except that it includes the limitation of "where a consumer having a unique identifier ...that is linked to the unique identifier of the consumer" which is the limitation in claims 17 and 18. Hence, it is rejected under the same rationale provided in claims 31, 17, and 18.

28. **As per claim 13**, this claim written in system form corresponds to claims 17 and 18. Hence, it is rejected under the same rationale provided in claims 17 and 18.

***Conclusion***

29. Claims 1-31 are rejected.
30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAI TRAN whose telephone number is (571)272-7364. The examiner can normally be reached on M-F, 9-4 PM.
31. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
32. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/  
Primary Examiner, Art Unit 3694

/H. T./  
Examiner, Art Unit 3694

